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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,883	07/31/2003	Daniel Kahne	PUAM-0257	1801

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EXAMINER
CELSA, BENNETT M

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/631,883	KAHNE ET AL.	
	Examiner	Art Unit	
	Bennett Celsa	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41,50-57,74-82 and 102-116* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-41, 50-57, 74-82 AND 102-116* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 1-41, 50-57, 74-82 AND 102-116 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-38 AND 102-116, drawn to a glycopeptide, classified in class 530, subclass 322.

II. Claims 39-41, drawn to a chemical library comprising a plurality of glycopeptides, classified in class 436, subclass 536.

III. Claim 57, drawn to a method of preparing a glycopeptide, classified in class 530, subclass 334 and 338.

IV.. Claims 50-56 and 74-82, drawn to a method of producing a chemical library, classified in class 436, subclass 7.1.

1. The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II represent independent and/or distinct inventions. Groups I and II are different, because each of the aforementioned groups represent different products: i.e. Group I is drawn to a glycopeptide (as distinguishable and represented by a different/unique chemical structure of formula I, which has different/unique chemical and physical properties), while Group II is drawn to a chemical library of a plurality of glycopeptides (comprised of different composition or a collection of two or more compounds, which have biological, therapeutic or some other functional uses). Therefore, Groups I and II have different issues

regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches (manual/computer in patent/literature databases).

3. Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, glycopeptide of Group I may be made by a process or method different from that defined by Group III. For example, glycopeptide compound of Group I may be synthesized by alternate synthetic routes in liquid or solid phases using different synthetic organic methods with different starting materials and reagents than by the processes of Group III.

4. Inventions I and IV represent independent and/or distinct inventions. Group I is different from Group III, because Group I is drawn to a glycopeptide (as represented by a different/unique chemical structure of formula I, which has different/unique chemical and physical properties), while Group IV is drawn to a method for preparing a chemical library, comprising a plurality of glycopeptides (which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s) or lead to different final results). Therefore, Group I and IV have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

5. Inventions II and III represent independent and/or distinct inventions. Group II is different from Group III, because Group II is drawn to a chemical library of a plurality of glycopeptides (a library is comprised of a different composition or a collection of two or more

compounds, which have biological, therapeutic or some other functional uses), while Group III is drawn to a method for preparing glycopeptides (which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s) or lead to different final results). Therefore, Groups II and III have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches

6. Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case , glycopeptide library of Group II may be made by a process of method different from that defined by Group IV. For example, glycopeptide library of Group II may be synthesized by alternate synthetic routes in liquid or solid phases using different synthetic organic methods with different starting materials and reagents than by the processes of Group IV.

7. Inventions III and IV represent independent and/or distinct inventions. Groups III and IV are drawn to different methods or processes (which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s) or lead to different final results). Therefore, Groups III and IV have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

8. Because these inventions are distinct for the reasons given above and

I. have acquired a separate status in the art as shown by their different classification,

II. require different manual/computer literature/classification searches; and/or

III. because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

RESTRICTION/ELECTION OF SPECIES *(For Groups I, II, III or IV)*

The Claims (e.g. see claims 1 and 102) are generic to a plurality of disclosed patentably distinct glycopeptide derivative compounds e.g. contain structurally diverse amino acid substituents; structurally diverse saccharide moieties; and varying positions relating thereto, which would possess different physico- chemico- and biological properties and/or are capable of separate making, use or manufacture. The search of all of the species within the presently claimed generic claims would be unduly burdensome to the Examiner since the search would require different manual/computer structure, bibliographic and/or name searches. Additionally, a complete search of the glycopeptides within the scope of claims 1 and 102 by the STIC-Biotech library is not possible nor feasible without an election of species requirement. Accordingly, the present election of species is necessary in order to obtain an adequate search of the presently claimed invention and in order to expedite the prosecution of the present application.

Applicants are hereby required to **elect a single compound species** which can be selected from the claims (e.g. from originally presented claims 83-101) or from

among the compounds listed in the specification examples, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

In order to facilitate searching, the **Examiner respectfully requests *that a chemical formula corresponding to the ultimate elected compound be submitted*** *(if available)* along with the response to this requirement.

Applicant is advised that a response to the above election requirement *must include an identification of the species that are elected consonant with these requirements, and* ***a listing of all claims readable thereon,*** *including any claims subsequently added*. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 571-272-0807. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-273-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bennett Celsa
Primary Examiner
Art Unit 1639

BC
November 17, 2004